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I hereby certify under 37 C.F.R. § 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Tracey Simmons
Printed name of person mailing correspondence

Tracey Simmons
Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

AUG 04 2004

Applicant: Robert A. Murgita Art Unit: 1647
Serial No.: 08/879,469 Examiner: Stephen Gucker
Filed: June 20, 1997 Customer No.: 21559
Title: RECOMBINANT HUMAN ALPHA-FETOPROTEIN AS A CELL
PROLIFERATIVE AGENT

OFFICE OF PETITIONS

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE APPLICATION UNDER 37 C.F.R. § 1.137(a)

Applicant hereby petitions under 37 C.F.R. § 1.137(a) to revive the above-captioned application, which was unavoidably abandoned on March 31, 2004 for failure to pay the issue fee in response to the Notice of Allowance that was mailed on March 21, 2003. The entire delay in paying the issue fee, from the due date for paying the issue fee until the filing of a grantable petition pursuant to this paragraph, was unavoidable. Applicant requests consideration of the following remarks in light of the Petition to Revive.

08/02/2004 HALI11 00000005 08879469

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REMARKS

Requirements for Filing a Petition to Revive:

Title 37 C.F.R. § 1.137(a) states that for an application that is unavoidably abandoned, Applicant must submit a petition to revive the abandoned application accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A statement that the entire delay in filing the required reply from the date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer, if required.

Applicant submits these required documents, herewith, and provides below a summary of the prosecution history to date outlining the reasons for the unavoidable abandonment of the above-referenced application.

Summary of Background History

In February 2002, Clark & Elbing, LLP, the law firm prosecuting the above-captioned application on behalf of the Applicant, moved their offices to a new location. The move necessitated the filing of a change of address in all of the applications handled by Clark & Elbing. Due to the substantial number of applications, it was decided that, rather than submit a change of correspondence address in each application, a process that would be highly burdensome, Clark & Elbing would submit a request to change the correspondence address using the "Customer Number" practice detailed in M.P.E.P. § 403, which states in relevant part:

A Customer Number (previously a "Payor Number") may be used to:

(A) designate the correspondence address of a patent application by a Customer Number such that the correspondence address for the patent application would be the address associated with the Customer Number... Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent)... Applicant may use either the same or different customer number(s) for the correspondence address... The following forms are suggested for use with the Customer Number practice:

- (A) the "Request for Customer Number" (PTO/SB/125) to request a Customer Number;
- (B) the "Request for Customer Number Data Change" (PTO/SB/124) to request a change in the data (address or list of practitioners) associated with an existing Customer Number;
- (C) the "Change of Correspondence Address, Application" (PTO/SB/122) to change the correspondence address of an individual application to the address associated with a Customer Number;
- (D) the "Change of Correspondence Address, Patent" (PTO/SB/123) to change the correspondence address of an individual patent to the address associated with a Customer Number; and
- (E) the "Correspondence Address Indication Form" (PTO/SB/121) to change the correspondence address of a list of applications or patents to the address associated with a Customer Number.

On March 15, 2002, a senior administrator at Clark & Elbing, Ms. Sheila Nestor, the individual who originally requested Customer Numbers for the firm, prepared and submitted three PTO/SB/124A forms ("Request for Customer Number Data Change") by facsimile to the Patent and Trademark Office; one form for each Customer Number utilized by Clark & Elbing (provided as Exhibit A). The forms requested that the correspondence address associated with Customer Numbers 21559, 31020, and 30091 be changed to 101 Federal Street, Boston, MA 02110, the new address for Clark & Elbing. The facsimile transmittal (included as Exhibit B) indicated that all pages were sent. In addition, a handwritten note by Ms. Nestor present on the facsimile transmittal evidences a follow-up telephone conversation in which "Marty at the PTO" confirms that the "Address changed to 101 Federal St." The undersigned representative of

Applicant, believing that the correspondence address associated with the present application (which is associated with Customer No. 21559) had been updated to the new address, took no further action.

Approximately one year after the change of address had been requested by Ms. Nestor, it was observed by employees of Clark & Elbing that correspondence for several unrelated applications and patents was still being forwarded from the old address of 176 Federal Street. Because the one year period of time for the forwarding of mail by the Postal service was due to expire in March 2003, a second attempt was initiated to associate patents and applications handled by Clark & Elbing with Customer Number 21559, for which the correspondence address was 101 Federal Street. On March 31, 2003, Ms. Susan Michaud, a partner at Clark & Elbing, submitted a list of patents and applications with a request to associate the listed patents and applications with Customer Number 21559 (letter and list provided as Exhibit C). Included among the list was the present application. On April 2, 2003, Mr. Tony Uranga at the Patent Office provided Ms. Michaud with an address error report and a request that the report be reviewed for accuracy (provided as Exhibit D). The report indicated that the correspondence address for the present application was still listed as 176 Federal Street, which was contrary to our understanding that the address had been changed as of March 15, 2002 to 101 Federal Street. Mr. Uranga stated in his e-mail message that, following confirmation of the information in the spreadsheet, the applications and patents listed would be associated with Customer Number 21559. On April 3, 2003, Ms. Michaud forwarded a revised list of applications and patents by e-mail to Mr. Uranga (provided as Exhibit E). Again, the present application was included among the list. On May 15, 2003, Mr. Uranga provided Clark & Elbing with a final list of applications

and patents to be associated with Customer Number 21559 (provided as Exhibit F).

On December 17, 2003, Clark & Elbing received an e-mail message from Ms. Rachel Allen at the Patent Office providing an attached report listing patents and applications for which an error was identified in the information listed for the patent or application (provided as Exhibit G). Ms. Allen requested that corrections be made and that the amended spreadsheet be resubmitted to the Patent Office via diskette accompanied by a cover letter signed by an attorney with a registration number associated with the customer number so that the listed applications could be associated with the Customer Number. The report indicated that the filing date for the present application was incorrectly provided as March 30, 1999, rather than the correct date of June 20, 1997. It is likely that this discrepancy prevented the present application from being timely associated with Customer Number 21559. For this reason as well, it is presumed that the correspondence address of the present application was not updated to 101 Federal Street as of March 15, 2002 when the original attempt to update the correspondence address for the present application was made.

Delay in Paying the Issue Fee was Unavoidable

M.P.E.P. § 711.03(c) states:

...where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address.

Applicant contends that the first attempt made by Ms. Nestor to update the correspondence address associated with Customer Number 21559, the Customer Number with which the present application is associated, was made according to the procedure outlined in M.P.E.P. § 403 and was more than sufficient to result in an updated correspondence address for the present application. Exhibits A and B clearly demonstrate that an employee of Applicant's representative, Ms. Nestor, requested an update in the correspondence address associated with Customer Number 21559 on March 15, 2002, well in advance of the date of issuance of the Notice of Allowance in the present application, and that Ms. Nestor received verbal confirmation on April 1, 2002 from an employee of the Patent Office ("Marty") that the correspondence address associated with Customer Number 21559 was updated to reflect the new address of 101 Federal Street, Boston MA 02110. Therefore, Applicant's representative, believing that the present application was associated with Customer Number 21559 and that the correspondence address associated with Customer Number 21559 had been appropriately updated, took no further action until such time as it was clear that the correspondence address had not been appropriately updated. After this realization, Applicant acted diligently to update the correspondence address in the present application.

Furthermore, M.P.E.P. § 403 states that the Patent Office will resolve "any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application...in favor of the address of the Customer Number." Therefore, Applicant had no reason to believe that correspondence from the Patent Office in connection with the present application would not be mailed to the new address for Applicant's representative,

as the correspondence address associated with Customer Number 21559 had been confirmed as being updated to 101 Federal Street and it was believed that the present application was associated with Customer Number 21559. As evidence that Applicant believed that the present application was associated with Customer Number 21559, Applicant submits a copy of the Terminal Disclaimer filed by Applicant on March 13, 2003, provided as Exhibit G, which indicates that the Customer Number with which the application is associated is 21559 (see page 1 of the Terminal Disclaimer). In addition, Applicant notes that the correspondence address listed at the end of the Terminal Disclaimer clearly indicates that the current address for Applicant's representative is 101 Federal Street, Boston MA 02110. Although Applicant understands that this by itself is not sufficient to direct the Patent Office to change the correspondence address, it is noted only as evidence that the new address was available to the Patent Office. Finally, because the last correspondence that Applicant received from the Patent Office in the present application was an Advisory Action dated October 24, 2001, Applicant had no reason to believe that the correspondence address in the present application had not been updated according to the Customer Number Practice to the new address of 101 Federal Street. Therefore, in light of the evidence that the correspondence address associated with Customer Number 21559 was confirmed changed to the new address of 101 Federal Street by a representative of the Patent Office, and because Patent Office practice requires that any inconsistencies between the correspondence address associated with a Customer Number and any other correspondence address provided in an application should be resolved in favor of the Customer Number address, Applicant submits that the Notice of Allowance in the present application should have been mailed to 101 Federal Street rather than the old address of 176 Federal Street.

Applicant's Representative Acted Diligently to Update the Correspondence Address

Applicant's representative acted diligently to update the correspondence address in the present application, both before the mailing date of the Notice of Allowance on March 21, 2003 and after this date, as is discussed above. Through no fault of the Applicant, the Notice of Allowance in the present application was mailed to the incorrect address, resulting in Applicant's failure to pay the issue fee. Due to the uncertainty with respect to what errors were made and by whom in connection with Applicant's representative's attempt to update the correspondence address in the present application, Applicant hereby petitions that the present application be revived. Applicant submits that the filing of this petition is timely as Applicant became aware of the status of the present application on March 1, 2004. Accordingly, Applicant respectfully requests that the Petitions Board favorably receive and grant this petition to revive.

CONCLUSION

Applicant submits that the delay in filing the enclosed reply was unavoidable and that this petition is being filed promptly after Applicant became aware that the application was abandoned.

Enclosed is a proposed reply to the Notice of Allowance, and a check for \$695.00 to cover the issue fee required by 37 C.F.R. § 1.18(a) of \$665.00 and the patent copy fee required under 37 C.F.R. § 1.19(a)(1)(i) of \$30.00 for ten patent copies.

Also enclosed is a check for \$55.00 in payment of the petition fee by a small entity as required by 37 C.F.R. § 1.17(l). Because this application was filed after June 8, 1995, no terminal disclaimer is required under 37 C.F.R. § 1.137(d).

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 28 July 2004

For 

Paul T. Clark
Reg. No. 30,162

TODD ARMSTRONG, Ph.D.

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